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10/782,195

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Carolyn Clancy

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EXAMINER

SWARTZ, JAMIE H

ART UNIT

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/782,195	<b>Applicant(s)</b> CLANCY ET AL.	
	<b>Examiner</b> JAMIE H. SWARTZ	<b>Art Unit</b> 3694	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 2/19/2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/21/2004</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-17 and 30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

3. Claim 1 is directed to comparing statuses of attributes but does not produce anything tangible. The act of comparing data does not result in a tangible invention. Based upon this analysis, the examiner asserts that the claimed invention does not set forth a practical application, since it does not produce a tangible result and therefore is rejected under 35 USC § 101.

4. Claim 30 is directed to comparing received statuses but does not produce anything tangible. The act of comparing data does not result in a tangible invention. Based upon this analysis, the examiner asserts that the claimed invention does not set forth a practical application, since it does not produce a tangible result and therefore is rejected under 35 USC § 101.

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Regarding claim 1, the phrase "comparing statuses of the attributes" renders the claim indefinite because it is unclear how a status of an attribute can be compared with another status of an attribute. What specifically is a status of an attribute?

8. Regarding claim 9, the phrase "are performed by the same entity" renders the claim indefinite because the phrase does not make sense within the structure of the claim.

9. Regarding claim 18, the phrase "uniquely associating" renders the claim indefinite because it is unclear what the applicant means by uniquely associating. How is something specifically uniquely associated? How does that compare to being not uniquely associated?

10. Regarding claim 18, the phrase "receiving the status of one or more of the one or more attributes" renders the claim indefinite because the language is unclear. How does one receive the status of one or more of the one or more?

11. Regarding claim 18, the phrase “status” renders the claim indefinite because it is unclear how the applicant defines status in the context of the claim. The specification (¶ 6) states that the status is offered and not offered. Is the employee comparing benefits that are offered with ones that are not offered?

12. Regarding claim 18, the phrase “action plan” renders the claim indefinite because it is unclear based in the specification what type of actions are included in an action plan.

13. Regarding claim 26, the phrase “metric” renders the claim indefinite because it is unclear which attributes are associated with the metrics.

### ***Claim Rejections - 35 USC § 102***

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

15. Claims 1-4, 6-11, 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Mahoney et al. (US 20030182147 A1).

16. Regarding claim 1, Mahoney teaches assessing the features an employee benefit plan (§§ 13-14). Mahoney teaches providing attributes of a first employee benefit plan, the plan having a plan sponsor and a plan record keeper (§§ 43-45, 52, 55-78). Mahoney teaches providing attributes of other employee benefit plans, each plan having a plan sponsor and a plan record keeper (§§ 43-45, 52, 55-78). Mahoney teaches determining a subset of the other employee benefit plans (§§ 34-54). Mahoney teaches comparing statuses of the attributes of the first employee benefit plan to statuses 8 of the attributes of the subset of the other employee benefit plans (§§ 34-54, 64-72).

17. Regarding claim 2, Mahoney teaches wherein the first employee benefit plan is one of a defined contribution plan, a pension plan, and employee stock purchase plan, a deferred compensation plan, and a healthcare plan (§§ 28, 55-58, 25, 30, 49, 92, 122, 146, 8, 23, 45, 47).

18. Regarding claim 3, Mahoney teaches wherein at least one of the other benefit plans is of the same type of employee benefit plans as the first employee benefit plan (§§ 55-78).

19. Regarding claim 4, Mahoney teaches wherein the defined contribution plan is one of a 401 (k) plan and a 403(b) plan (§§ 25, 28, 55, 65).

20. Regarding claim 6, Mahoney teaches the record keeper of the plan providing the attributes of the first employee benefit plan to the sponsor of the plan (§ 64-72).

21. Regarding claim 7, Mahoney teaches the record keeper of the first plan providing the attributes of the other benefit plans to the sponsor of the first plan (§ 64-72).

22. Regarding claim 8, Mahoney teaches the sponsor of the first plan providing the attributes of the first employee benefit plan to the record keeper of the first plan (§ 64-72).

23. Regarding claim 9, Mahoney teaches wherein the record keeper performs record keeping functions for at least two of other employee benefit plans are performed by the same entity (§ 64-72).

24. Regarding claim 10, Mahoney teaches wherein the record keeping functions for the other employee benefit plans are performed by at least two different entities (§ 64-72).

25. Regarding claim 11, Mahoney teaches using the characteristics of the plan sponsors to determine a subset of the other employee benefit plans (§ 64-72).

26. Regarding claim 13, Mahoney teaches wherein the first employee benefit plan is in the subset of employee benefit plans (§ 34-54, 64-72).

***Claim Rejections - 35 USC § 103***

27. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

28. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mahoney et al. (US 20030182147 A1) in view of Manning (US 20040088236 A1).

29. Regarding claim 5, Mahoney teaches providing attributes of employee benefit plans, determining subsets of plans, and comparing statuses of attributes. Mahoney does not specifically teach a 457 plan. However, Manning teaches wherein the deferred compensation plan is a 457 plan (§ 18, 25). Mahoney teaches various employee benefit plan options. Manning teaches an analysis and modeling of retirement investments during a pre-retirement accumulation phase and a post-retirement distribution phase with various employee benefits plan options. The claim is rejected under 35 USC 103 as obvious over the primary reference in view of the secondary reference. The primary reference teaches different employee benefit plan options including options such as the 401 (k) plan. The sole difference between the primary reference and the claimed subject



matter is that the primary reference does not disclose the 457 plan. The secondary references disclose the 457 plan which is a non-qualified, deferred compensation plan established by state and local governments and tax-exempt governments and tax-exempt employers. Eligible employees are allowed to make salary deferral contributions to the 457 plan. Earnings grow on a tax-deferred basis and contributions are not taxed until the assets are distributed from the plan. The secondary reference shows the use of the 457 plan. Since each individual element and its function are shown in the prior art, albeit shown in separate references, the difference between the claimed subject matter and the prior art rests not on any individual element or function but in the very combination itself- that is the substitution of the 457 plan. Thus, the simple substitution of one known element for another produces a predictable result renders the claim obvious.

30. Claims 12, 14-17, 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mahoney et al. (US 20030182147 A1) in view of Newman (US 20020103680 A1).

31. Regarding claim 12, Mahoney teaches providing attributes of employee benefit plans, determining subsets of plans, and comparing subsets of attributes. Mahoney does not specifically teach determining the subsets. However Newman teaches wherein the characteristics used to determine the subset includes one or more of: the number of employees, industry, non-profit status, and geographic region (§ 103, 208). Mahoney

teaches various employee benefit plan options. Newman teaches managing the provision and administration of employee benefits. Both Mahoney and Newman teach employee plan benefits. Mahoney teaches all the claimed process steps with the exception of the specific characteristics to determine subsets. Newman teaches the characteristics claimed for setting up a subset. Since the purpose of locating characteristics for the subset is to better assess an employee benefit plan it would have been obvious to include more specific details about the employee benefit plan. The number of employees, the industry, the non-profit status, and location all are major factors in assessing the attributes of an employee benefit plan. Each of those factors affects features that are available and even the rates of the features that are available. The practice of assessing a group of employee benefit plans based on key characteristics is well known in the business community. When figuring out which features should be involved in a subset it is always important to note key features. Therefore, it would have been obvious to try, by one of ordinary skill in the art at the time of the invention, to pick the number of employees, the industry, the non-profit status, or the location as key characteristics to creating a subset of employee benefit plans and one of ordinary skill in the art could have pursued the known potential solutions with a reasonable expectation of success.

32. Regarding claim 14, Mahoney teaches providing attributes of employee benefit plans, determining subsets of plans, and comparing statues of attributes. Mahoney does not specifically teach performing a comparison step for the claimed plan metrics.

However Newman teaches performing the comparison step for one or more of the following plan metrics: plan participation, plan diversification, participant contribution levels, participant account balances, and participant interaction (§ 11-49, 103, 208). Mahoney teaches various employee benefit plan options. Newman teaches managing the provision and administration of employee benefits. Both Mahoney and Newman teach employee plan benefits. Mahoney teaches all the claimed process steps with the exception of the specific metrics. Newman teaches the characteristics claimed for setting up a plan metrics. Since the purpose of locating characteristics for the plan metrics is to better assess an employee benefit plan it would have been obvious to include more specific details about the employee benefit plan. The plan participation, plan diversification, participant contribution levels, participant account balances, and participant interaction all are major factors in assessing the attributes of an employee benefit plan. Each of those factors affects features that are available and even the rates of the features that are available. The practice of assessing a group of employee benefit plans based on key characteristics is well known in the business community. When figuring out which features should be involved in a plan metric it is always important to note key features. Therefore, it would have been obvious to try, by one of ordinary skill in the art at the time of the invention, to pick the number of employees, the industry, the non-profit status, or the location as key characteristics to creating a plan metrics of employee benefit plans and one of ordinary skill in the art could have pursued the known potential solutions with a reasonable expectation of success.

33. Regarding claim 15, Mahoney teaches providing attributes of employee benefit plans, determining subsets of plans, and comparing statuses of attributes. Mahoney does not specifically teach performing a comparison step for a sub-metrics. However Newman teaches performing the comparison step for one or more sub-metrics of the one or more metrics (§§ 11-49, 103, 208). Mahoney teaches various employee benefit plan options. Newman teaches managing the provision and administration of employee benefits. Both Mahoney and Newman teach employee plan benefits. Mahoney teaches all the claimed process steps with the exception of the specific characteristics to determine subsets. Newman teaches the characteristics claimed for setting up a plan metrics. Since the purpose of locating characteristics for the plan metrics is to better assess an employee benefit plan it would have been obvious to include more specific details about the employee benefit plan. It was well known in the art at the time of the invention that a comparison step is more effective in the evaluation of an attribute the more facts that are involved. The more data metrics involved in any type of comparison leads to a more accurate comparison.

34. Regarding claim 16, Mahoney teaches providing attributes of employee benefit plans, determining subsets of plans, and comparing statuses of attributes. Mahoney does not specifically teach the sub-metrics claimed. However Newman teaches wherein the sub-metrics are one or more of the following: the age of plan participants, the diversification of plan options, and customer service channels used by plan participants (§§ 11-49, 103, 208). Mahoney teaches various employee benefit plan options. Newman

teaches managing the provision and administration of employee benefits. Both Mahoney and Newman teach employee plan benefits. Mahoney teaches all the claimed process steps with the exception of the specific characteristics to determine subsets. Newman teaches the characteristics claimed for setting up a sub-metrics. Since the purpose of locating characteristics for the sub-metrics is to better assess an employee benefit plan it would have been obvious to include more specific details about the employee benefit plan. The age of plan participants, the diversification of plan options, and customer service channels used by plan participants all are major factors in assessing the attributes of an employee benefit plan. Each of those factors affects features that are available and even the rates of the features that are available. The practice of assessing a group of employee benefit plans based on key characteristics is well known in the business community. When figuring out which features should be involved in a sub-metric it is always important to note key features. Therefore, it would have been obvious to try, by one of ordinary skill in the art at the time of the invention, to pick the number of employees, the industry, the non-profit status, or the location as key characteristics to creating a sub-metrics of employee benefit plans and one of ordinary skill in the art could have pursued the known potential solutions with a reasonable expectation of success.

35. Regarding claim 17, Mahoney teaches providing attributes of employee benefit plans, determining subsets of plans, and comparing statues of attributes. Mahoney does not specifically teach performing a comparison step for a sub-metrics. However

Newman teaches performing the comparison step for one or more sub-sub-metrics of the one or more sub-metrics (§§ 11-49, 103, 208). Mahoney teaches various employee benefit plan options. Newman teaches managing the provision and administration of employee benefits. Both Mahoney and Newman teach employee plan benefits.

Mahoney teaches all the claimed process steps with the exception of the specific characteristics to determine subsets. Newman teaches the characteristics claimed for setting up a plan metrics. Since the purpose of locating characteristics for the sub-metrics is to better assess an employee benefit plan it would have been obvious to include more specific details about the employee benefit plan. It was well known in the art at the time of the invention that a comparison step is more effective in the evaluation of an attribute the more facts that are involved. The more data metrics involved in any type of comparison leads to a more accurate comparison.

36. Regarding claim 26, Mahoney teaches providing attributes of employee benefit plans, determining subsets of plans, and comparing statuses of attributes. Mahoney does not specifically teach performing a comparison step for the claimed plan metrics.

However Newman teaches associating the attributes of the first employee benefit plan with one or more metrics of the first employee benefit plan (§§ 11-49, 103, 208).

Mahoney teaches various employee benefit plan options. Newman teaches managing the provision and administration of employee benefits. Both Mahoney and Newman teach employee plan benefits. Mahoney teaches all the claimed process steps with the exception of the specific characteristics to determine metrics. Newman teaches the

characteristics claimed for setting up a plan metrics. Since the purpose of locating characteristics for the plan metrics is to better assess an employee benefit plan it would have been obvious to include more specific details about the employee benefit plan. The practice of assessing a group of employee benefit plans based on a metric is well known in the business community. When figuring out which features should be involved in a plan metric it is always important to note key features. Therefore, it would have been obvious to try, by one of ordinary skill in the art at the time of the invention, to create a plan metrics to associate with the attributes of employee benefit plans and one of ordinary skill in the art could have pursued the known potential solutions with a reasonable expectation of success.

37. Regarding claim 27, Mahoney teaches providing attributes of employee benefit plans, determining subsets of plans, and comparing statues of attributes. Mahoney does not specifically teach performing a comparison step for the claimed plan metrics. However Newman teaches wherein the one or more metrics are one or more of: plan participation, plan diversification, participant contribution levels, participant account balances, and customer interaction (§ 11-49, 103, 208). Mahoney teaches various employee benefit plan options. Newman teaches managing the provision and administration of employee benefits. Both Mahoney and Newman teach employee plan benefits. Mahoney teaches all the claimed process steps with the exception of the specific characteristics to determine metrics. Newman teaches the characteristics claimed for setting up a plan metrics. Since the purpose of locating characteristics for

the plan metrics is to better assess an employee benefit plan it would have been obvious to include more specific details about the employee benefit plan. The plan participation, plan diversification, participant contribution levels, participant account balances, and customer interaction all are major factors in assessing the attributes of an employee benefit plan. Each of those factors affects features that are available and even the rates of the features that are available. The practice of assessing a group of employee benefit plans based on key characteristics is well known in the business community. When figuring out which features should be involved in a plan metric it is always important to note key features. Therefore, it would have been obvious to try, by one of ordinary skill in the art at the time of the invention, to pick the number of employees, the industry, the non-profit status, or the location as key characteristics to creating a plan metrics of employee benefit plans and one of ordinary skill in the art could have pursued the known potential solutions with a reasonable expectation of success.

38. Regarding claim 28, Mahoney teaches providing attributes of employee benefit plans, determining subsets of plans, and comparing statues of attributes. Mahoney does not specifically teach performing a comparison step for metrics. However Newman teaches performing the comparison step for one or more of the metrics (§¶ 11-49, 103, 208). Mahoney teaches various employee benefit plan options. Newman teaches managing the provision and administration of employee benefits. Both Mahoney and Newman teach employee plan benefits. Mahoney teaches all the claimed process steps



with the exception of the specific characteristics to determine subsets. Newman teaches the characteristics claimed for setting up a plan metrics. Since the purpose of locating characteristics for the plan metrics is to better assess an employee benefit plan it would have been obvious to include more specific details about the employee benefit plan. It was well known in the art at the time of the invention that a comparison step is more effective in the evaluation of an attribute the more facts that are involved. The more data metrics involved in any type of comparison leads to a more accurate comparison.

39. Claims 18-22, 24-25, 29-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mahoney et al. (US 20030182147 A1) in view of Manning (US 20040088236 A1).

40. Regarding claim 18, Mahoney teaches an improvement action for one or more attributes of an employee benefit plan receiving the status of one or more of the one or more attributes of a first employee benefit plan identifying the attributes of the first employee benefit plan which have a different status than a set of other employee benefit plans; and providing a plan to improve the first employee benefit plan, the action plan comprising one or more of the actions associated with the identified attributes (§§ 30, 35, 52-53, 65, 84, 89-91, 98, 107-118). Manning teaches a plan to change the benefit plan (§§ 6, 26, 30-36). Taking a plan and coming up with actions to improve that specific plan is old and well known in the art of business any change management.

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41. Regarding claim 19, Mahoney teaches wherein the first employee benefit plan is one of a defined contribution plan, a pension plan, and employee stock purchase plan, a deferred compensation plan, and a healthcare plan (§§ 28, 55-58, 25, 30, 49, 92, 122, 146, 8, 23, 45, 47).

42. Regarding claim 20, Mahoney teaches wherein the defined contribution plan is one of a 401 (k) plan and a 403(b) plan (§§ 25, 28, 55, 65).

43. Regarding claim 21, Mahoney teaches providing attributes of employee benefit plans, determining subsets of plans, and comparing statues of attributes. Mahoney does not specifically teach a 457 plan. However, Manning teaches wherein the deferred compensation plan is a 457 plan (§§ 18, 25). Mahoney teaches various employee benefit plan options. Manning teaches an analysis and modeling of retirement investments during a pre-retirement accumulation phase and a post-retirement distribution phase with various employee benefits plan options. The claim is rejected under 35 USC 103 as obvious over the primary reference in view of the secondary reference. The primary reference teaches different employee benefit plan options including options such as the 401 (k) plan. The sole difference between the primary reference and the claimed subject matter is that the primary reference does not disclose the 457 plan. The secondary references disclose the 457 plan which is a non-qualified, deferred compensation plan established by state and local governments and tax-exempt governments and tax-exempt employers. Eligible employees are allowed to make salary deferral contributions

to the 457 plan. Earnings grow on a tax-deferred basis and contributions are not taxed until the assets are distributed from the plan. The secondary reference shows the use of the 457 plan. Since each individual element and its function are shown in the prior art, albeit shown in separate references, the difference between the claimed subject matter and the prior art rests not on any individual element or function but in the very combination itself- that is the substitution of the 457 plan. Thus, the simple substitution of one known element for another produces a predictable result renders the claim obvious.

44. Regarding claim 22, Mahoney teaches selecting the employee benefit plans to be included in the set of other employee benefit plans based at least in part on characteristics of the sponsors of the other employee benefit plan (§§ 14, 34-51).

45. Regarding claim 24, Mahoney teaches requesting the status from the record keeper of the first employee benefit plan (§§ 64, 71, 81, 102, 120, 138-141).

46. Regarding claim 25, Mahoney teaches requesting the status from the sponsor of the 2 first employee benefit plan (§§ 64, 71, 81, 102, 120, 138-141).

47. Regarding claim 29, Mahoney teaches wherein the action plan is displayed on one or more of a printed report and a web page (§§ 80, 84, 88).

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48. Regarding claim 30, Mahoney teaches means for storing attributes of a plurality of employee benefit plans; means for segmenting the employee benefit plans into groups based on characteristics of the plan sponsors; means for deriving a benchmark for each group of plans; means for transmitting attributes of an employee benefit plan to a user; means for receiving an indication of a status of the attributes of the employee benefit plan from the user; and means for comparing the received status with the benchmark (§§13, 39, 124, 29, 34-54, 58, 64-72, 86, 93-99, 124, 151, claim 1). Mahoney does not specifically teach performing a comparison step for the claimed plan metrics. However Newman teaches performing the comparison step for one or more of the following plan metrics: plan participation, plan diversification, participant contribution levels, participant account balances, and participant interaction (§§ 11-49, 103, 208). Mahoney teaches various employee benefit plan options. Newman teaches managing the provision and administration of employee benefits. Both Mahoney and Newman teach employee plan benefits. Mahoney teaches all the claimed process steps with the exception of the specific metrics. Newman teaches the characteristics claimed for setting up a plan metrics. Since the purpose of locating characteristics for the plan metrics is to better assess an employee benefit plan it would have been obvious to include more specific details about the employee benefit plan. The plan participation, plan diversification, participant contribution levels, participant account balances, and participant interaction all are major factors in assessing the attributes of an employee benefit plan. Each of those factors affects features that are available and even the rates of the features that are available. The practice of assessing a group of employee benefit

plans based on key characteristics is well known in the business community. When figuring out which features should be involved in a plan metric it is always important to note key features. Therefore, it would have been obvious to try, by one of ordinary skill in the art at the time of the invention, to pick the number of employees, the industry, the non-profit status, or the location as key characteristics to creating a plan metrics of employee benefit plans and one of ordinary skill in the art could have pursued the known potential solutions with a reasonable expectation of success.

49. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mahoney et al. (US 20030182147 A1) in view of Manning (US 20040088236 A1) in further view of Official Notice.

50. Regarding claim 23, Mahoney and Manning teach employee benefit plans. The combination of Mahoney and Manning does not specifically state the use of a questionnaire. However, Official Notice is taken that an online questionnaire was an old and well known mode of collecting information from customer, clients, even students.

51. Examiner's Note: The Examiner has cited particular columns and line numbers in the references as applied to the claims for the convenience of the applicant.

Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the

responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMIE H. SWARTZ whose telephone number is (571)272-7363. The examiner can normally be reached on 8:00am-4:30pm Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/J. H. S./  
Examiner, Art Unit 3694

/James P Trammell/  
Supervisory Patent Examiner, Art Unit 3694